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Shirley J. Provinse

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EXAMINER

AKINTOLA, OLABODE

ART UNIT

PAPER NUMBER

3691

NOTIFICATION DATE

DELIVERY MODE

04/28/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 09/943,438	Applicant(s) PROVINSE, SHIRLEY J.	
	Examiner OLABODE AKINTOLA	Art Unit 3691	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 January 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,5,6,11-16 and 25-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1,2,5,6,11-16 and 25-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/9/2009 has been entered.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

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A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-2, 5-6, 11-16, 25-39 and 40-41 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 5-25 of copending Application No. 11/619110. Although the conflicting claims are not identical, they are not patentably distinct from each other.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-2, 5-6, 11-16, 25-39 and 40-41 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 6-23 of copending Application No. 11/619280. Although the conflicting claims are not identical, they are not patentably distinct from each other.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-2, 5-6, 11-16, 25-39 and 40-41 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 5-25 of

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copending Application No. 11/619290. Although the conflicting claims are not identical, they are not patentably distinct from each other.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-2, 5-6, 11-16 and 25-41 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Here, the state of the law with respect to statutory subject matter eligibility under §101 is evolving and is presently an issue in several cases under appeal at the Federal Circuit with regard to process claims. As presently understood, based on Supreme Court precedent and recent Federal Circuit decisions, [see *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)] a §101 statutory process must (1) be tied to another statutory class (e.g. such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. If neither of these requirements is met, a method is not a patent eligible process under §101 and should be rejected as being directed to non-statutory subject matter.

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For example, a method claim that recites purely mental steps (e.g. can be performed by mental process or human intelligence alone) would not qualify as a statutory process. To qualify as a §101 statutory process, the claim should (1) positively recite another statutory class (e.g. thing or product) to which it is tied (e.g. by identifying the apparatus that accomplishes the method steps) or (2) positively recite the subject matter that is being transformed (e.g. by identifying the material that is being changed to a different state).

Examiner notes that the machine-or-transformation test is a two-branched inquiry; an applicant may show that a process claim satisfies § 101 either by showing that his claim is tied to a particular machine, or by showing that his claim transforms an article. See *Benson*, 409 U.S. at 70. Certain considerations are applicable to analysis under either branch. First, as illustrated by *Benson*, the use of a specific machine or transformation of an article must impose meaningful limits on the claim's scope to impart patent-eligibility. See *Benson*, 409 U.S. at 71-72. Second, the involvement of the machine or transformation in the claimed process must not merely be insignificant extra-solution activity. See *Flook*, 437 U.S. at 590.

Regarding claims 1-2, 5-6, 11-16 and 25-41, Examiner notes that all the other limitations except “associating, by said processor, a second charge in said financial database with said first data of said travel record in said travel database, wherein said travel record in said travel database does not include said second charge in said financial database, and wherein said second charge in said financial database is associated with a change to said travel record in said travel database; and assigning, by said processor, said second charge in said financial database to said department code associated with said travel record in said travel database” do not impose any meaningful

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limit on the scope of the claim and is merely insignificant extra-solution activity (i.e the steps are not critical to the inventive step of the invention).

Since the critical step (i.e. “associating, by said processor, a second charge in said financial database with said first data of said travel record in said travel database, wherein said travel record in said travel database does not include said second charge in said financial database, and wherein said second charge in said financial database is associated with a change to said travel record in said travel database; and *assigning, by said processor, said second charge in said financial database to said department code associated with said travel record in said travel database*”) is not tied to a machine or processor (see page 28, paragraph [0070] of the originally filed disclosure, see also 35 USC 112, first paragraph rejection below), the claims do not qualify as a §101 statutory process.

Also, claim 25 recite a computer-readable medium having stored thereon a plurality of instructions, however, this is simply a medium having information stored thereon. Since the instructions are not being executed per se, the do not have any functionality. Examiner suggests amending the claim 25 to include in the preamble, “...the plurality of instructions which when executed on a computer perform a method of providing account reconciliation for an account comprising the steps of: providing....”

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it

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pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-2, 5-6, 11-16 and 25-41 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In particular claims 1, 11 and 25 recite “associating, by said processor, a second charge in said financial database with said first data of said travel record in said travel database, wherein said travel record in said travel database does not include said second charge in said financial database, and wherein said second charge in said financial database is associated with a change to said travel record in said travel database; and assigning, by said processor, said second charge in said financial database to said department code associated with said travel record in said travel database”.

There is no support for these limitations in the originally filed disclosure. Applicant is requested to cite portion(s) of the originally filed disclosure that teaches these limitations. Examiner notes that the above recited steps are expressly carried out by a human being according to the originally filed disclosure (see page 28, paragraph [0070]).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are

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such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-2, 5-6, 11-16, 25-39 and 40-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vance et al (USPN 6442526) in view of Dunn et al (USPN 5134564).

Re claims 1-2, 5, 11-15, 25-39: Vance teaches a method (and corresponding system and computer readable medium) of providing account reconciliation for an account comprising the steps of: matching, at a processor, a first charge to a first amount of a travel record in a travel database, wherein a department code (*reference or identifying code or number*) is associated with said travel record in said travel database, and wherein said travel record includes said first amount and first data; and assigning, by said processor, said first charge to said department code by writing said departmental code to a field corresponding to said first charge in said financial database; associating, by said processor, a second charge in said financial database with said first data of said travel record in said travel database, and wherein said second charge is associated with a change to said travel record (see figs. 16I and 17 ele. 1700-1750, col. 13, lines 36 through col. 14, lines 65; col. 2, lines 1-3).

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Vance does not explicitly teach associating, by said processor, a second charge in said financial database with said first data of said travel record in said travel database, wherein said travel record in said travel database does not include said second charge in said financial database, and wherein said second charge in said financial database is associated with a change to said travel record in said travel database; and assigning, by said processor, said second charge in said financial database to said department code associated with said travel record in said travel database.

However, Vance teaches ticket tracking process that reports on status of any ticket, lists tickets that have been refunded or voided, list tickets returned for refund which have not been credited, and reports unrefunded tickets (col. 10, lines 27-35).

Dunn teaches selecting or rejecting by either *human intervention* or by *automatic processing* a probable match for unmatched records. For each probable match accepted, the accepted match pair, including a record from a first list and a record from the second list, is then removed from further processing. The probable matching steps are repeated until all acceptable probable matches have been determined. Thereafter, if unmatched records exist in the first list, further processing continues. *For example, if no probable match exists, it may be determined that the lack of a likely match results from the omission of a record in the second list and the match can be made by insertion of a corresponding record in the second list so that a matched pair in the first and second list results.* For example, such a record insertion often is necessary in a customer listing to correspond with a service charge in the first listing from a bank statement (col. 3, line 52 through col. 4, line 26). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Vance to include the concept of resolving

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unmatched records such as when a refund or exchange is made (*second charge associated with a change to merchant transaction*) which result in an omission of a corresponding charge in the merchant database, by using human intervention or automatic processing as taught by Dunn. One would have been motivated to do so in order to generate a match by assigning probability values to differences between elements being compared (such as department codes, amount, date, reference or identifying code or number, etc).

Re claims 6, 16 and 40-41: Vance teaches compiling matches and generating a report from the compilation (fig. 17). Vance does not explicitly teach compiling near matches. Dunn teaches compiling near matches (col. 3, lines 19- 24; col. 3, line 52- col. 32, line 13; col. 20, lines 26-30; Fig. 2). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Vance to include this steps as taught by Dunn in order to speed up the account reconciliation process by determining probably matches using matching criteria.

Response to Arguments

Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to OLABODE AKINTOLA whose telephone number is (571)272-3629. The examiner can normally be reached on M-F 8:30AM -5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on 571-272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Olabode Akintola/
Examiner, Art Unit 3691